

## **Remarks**

The various parts of the Office Action (and other matters, if any) are discussed below under appropriate headings.

### ***Non-Final/Final Office Action***

According to the cover page of the Office Action, the Office Action is non-final. The Examiner elsewhere indicates the Office Action is final. Thus, the status of the last Office Action is not clear and applicant is entitled to a clear statement of the status of the Office Action.

In the absence of such a clear statement and in an effort to advance the prosecution of this application to grant, claim 19 has been amended to define more clearly over the applied references for the reasons discussed below. The other amendments are made to address the non-art issues raised by the Examiner.

In view of the foregoing, entry of the amendments is respectfully requested. It is further requested that the last Office Action not be treated as final in view of the ambiguous indication of its status as both non-final and final.

### ***Claim Rejections - 35 USC § 112***

Regarding the rejection of claim 23, the Examiner's suggested amendment has been adopted and accordingly the rejection is now moot.

Regarding claim 27, the amendments should remove the basis for the alleged indefiniteness.

### ***Claim Rejections - 35 USC § 102 and § 103***

Claim 19 has been further amended in order to further distinguish patentably over the references applied to reject claim 19. Claim 19 now additionally recites "side portions disposed at an angle and extending between the front and rear faces for covering the corner edge region of the frame" and "at least one of said opposite faces being triangular in plan view and resilient and smoothly bowed towards the other face".

Neither Wilde nor Wilde et al. disclose side portions that primarily cover the board with which they are used since large gaps are required to form, for example, the springs 18. Thus, the protectors of Wilde and Wilde et al. would not be a sufficient

sideways barrier to dirt or grit, which could enter the corner protector and damage the goods it is trying to protect. Furthermore, the side portions of the claimed corner protector can function as primary resting surfaces.

The applied references also fail to teach, "at least one of said opposite faces being ... resilient and smoothly bowed towards the other face". The mouth of the corner protector in Wilde or Wilde et al. employs parallel front and rear faces. Therefore, in order to place a board into the corner protector a user will have to pry the front and rear faces apart before attempting to insert the board's corner into the corner protector. The corner protector of claim 19 enables a side of the mouth of the corner protector to be of sufficient size to allow the insertion of a picture frame apex and then by sliding the picture frame apex against the side portion and towards a more central position, the picture frame's outermost edge finds itself trapped behind the bowed portion of at least one of the front and rear faces of the corner protector.

The skilled person would not consider the addition of Mehl because Mehl does not indicate how a longitudinal edge protector could be adapted to go around a corner. The structure of Figure 1 for example shows the rigid portion 12.4 and a soft portion 14 without any indication of how it could be made to conform around a corner. Even hypothetically considering the combination of Wilde, Wilde et al. and Mehl, the skilled person would not arrive at the claimed combination of features. The skilled person would seemingly instead simply modify the springs 18 of the side portions to be corrugated with multiple bowed elements as part of the side portions. Alternatively, the skilled person could render the entire corner protector rigid apart from adding a soft portion such as soft teeth 14 inside the mouth of Wilde's corner protector. Such teeth would however cause pressure points on the picture frame that could damage the frame.

Modifying the side portions to be primarily covering portions and then incorporating the spring in the front and rear faces by bowing one of the front or rear faces would be several steps too far for the non-inventive skilled person.

With regards to the rejection based on Speshyock and Morley et al., it is respectfully submitted it would not be obvious to combine these reference because of their disparate fields. The classifications for Speshyock are 40/778 and 248/488 while those of Morley et al. are 428/122, 428/182, 428/184, 428/213 and 206/453.

Even hypothetically considering the combination of these two documents, the edge protector of Morley et al. in Figure 3 is not smoothly bowed since it incorporates a kink 140 along a longitudinal fold line. The longitudinal fold line would not be

considered as appropriate because it forms a sharp edge, which would dig into a picture frame. This is particularly relevant when stacking a number of picture frames because a sharp edge could leave scores when pressure is applied during transportation.

Speshyock also teaches against the use of a smoothly bowed front and rear face since it discloses the use of spikes 26. This configuration would not be suitable for fitting a corner protector directly onto the edge of a picture frame since like the edge in Morley et al. these would have the tendency to considerably damage the surface of the picture frame. As the description of Speshyock states these must be pressed to the back of the foam board to connect the board to the corner frames. These cannot be used to directly connect the corner protector to the picture frame without causing considerable damage.

Even hypothetically considering the combination of Speshyock and Morley et al., the skilled person would at best put a fold line in the front and/or rear surface of the corner protector in Speshyock which would also result in scratching of the surface of the picture frame.

For at least the foregoing reasons, a corner protector as recited in claim 19 is not obvious. The rejections should be withdrawn with respect to the other claims for at least the same reasons.

### ***Allowable Subject Matter***

The allowance of claim 21 and indicated allowability of claims 23, 24 and 27 is noted with appreciation.

### ***Conclusion***

In view of the foregoing, request is made for timely issuance of a notice of allowance.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

/Don W. Bulson/

By \_\_\_\_\_  
Don W. Bulson, Reg. No. 28,192

1621 Euclid Avenue  
Nineteenth Floor  
Cleveland, Ohio 44115  
(216) 621-1113  
M:\INPLT\IP0102\IP0102US-R02.wpd